

REMARKS

Applicants thank the Examiner for the very thorough consideration given the present application. Claims 1-3, 5, 6, 12 and 15 are currently pending in this application. None of the claims have been amended. The Specification has been amended to identify previous "Examples 1-8" as comparative or "Referential Examples 1-8", as they now fall outside of the scope of the present invention based on previous claim amendments. Accordingly, no new matter has been added.

In view of the amendments and remarks herein, Applicants respectfully request that the Examiner withdraw all outstanding rejections and allow the currently pending claims.

Issues Under 35 U.S.C. 103(a)

Claims 1-3 and 5-6 stand rejected under 35 U.S.C. 103(a) as being obvious over Jenkins et al. (U.S. 5,637,143) (hereinafter Jenkins '143) in view of Schmid et al. (U.S. 5,364,467) (hereinafter Schmid '467) in further view of Mei et al. (U.S. 6,894,089) (hereinafter Mei '089). Additionally, claims 12 and 15 stand rejected as being obvious over Jenkins '143 in view of Schmid '467, Mei '089 and Shimizu et al. (U.S. 4,842,837) (hereinafter Shimizu '837). Applicants respectfully traverse.

The Examiner asserts that Jenkins '143 teaches an anti-corrosive aluminum pigment of high metallic luster, treated with phosphomolybdic acid. The Examiner acknowledges that Jenkins '143 fails to teach or suggest that the pigment is coated with silica, or that the pigment is further coated with a coating prepared from a silane composition. The Examiner relies on the teachings of Schmid '467 and Mei '089 to overcome these deficiencies.

Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Additionally, there must be a reason why one of ordinary skill in the art would modify the reference or combine reference teachings to obtain the invention. A patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. *KSR Int'l Co. v Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007). There must be a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. *Id.* The Supreme Court of the United States has recently held that the "teaching, suggestion, motivation test" is a valid test for obviousness, albeit one which cannot be too rigidly applied. *Id.* Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *Id.*

Jenkins '143 discloses an aluminum pigment treated with a molybdenum coat (see, e.g., col. 2, lines 34-65). However, as correctly asserted by the Examiner, Jenkins '143 fails to teach or suggest an aluminum pigment comprising a silica coat covering the molybdenum coat, or a coat prepared from a silane coupling agent on said silica coat. Schmid '467 and Mei '089 fail to cure these deficiencies.

Schmid '467 discloses treating a molybdenum-coated aluminum pigment with silicon oxide (see, e.g., col. 3, lines 3-28). Mei '089 discloses surface treatment of pigments with organosilicon compounds having at least one functional group capable of reacting with an acid or

an anhydride (see, e.g., col. 1, lines 9-17). However, Applicants submit that none of the references teach or suggest the simultaneous use of three coatings on the aluminum pigment (i.e., molybdenum, silica and silane coupling agent) as presently claimed (see, e.g., claim 1).

The Examiner's attention is respectfully directed to the enclosed Declaration Under 37 C.F.R. 1.132, which shows that the present invention is superior and exhibits unexpected and advantageous properties over the prior art of record. Specifically, the Declaration shows that superior results are obtained when combining three coatings (i.e., molybdenum, silica and a silane coupling agent), as compared to the case where only one coating or two coatings is/are applied.

As evidenced by the results discussed in the enclosed Declaration, only the pigment corresponding to present claim 1 is ranked as superior (i.e., a rating of "5") in terms of both the color tone of the painted plate and the base adhesion of the film (moisture resistance/adhesiveness) (emphasis added). Furthermore, this pigment generates absolutely no gas.

In stark contrast, the pigments in accordance with the prior art may exhibit either a good color tone of the painted plate or good moisture resistance/adhesiveness, **but none of them exhibit superior results in terms of both of these properties** (emphasis added).

Applicants submit that the superior results obtained by the present pigment are unexpected and rebut any *prima facie* case of obviousness arguably established by the Examiner. As such, reconsideration and withdrawal of this rejection are respectfully requested.

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and objections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action and, as such, the present application is in condition for allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Vanessa Perez-Ramos, Reg. No. 61,158 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Dated: AUG 17 2009

Respectfully submitted,

By 

Craig A. McRobbie
Registration No.: 42,874
BIRCH, STEWART, KOLASCH & BIRCH, LLP
8110 Gatehouse Road
Suite 100 East
P.O. Box 747
Falls Church, Virginia 22040-0747
(703) 205-8000
Attorney for Applicant

Attachment: Executed Declaration Under 37 CFR 1.132